Remarks

Claims 1 – 38, 40 – 58, 60 and 61 are rejected under 35 U.S.C. §103(a) as being obvious over a hypothetical combination of Dehlin and Goodspeed. Applicants respectfully traverse. These claims were previously rejected under 35 U.S.C. §102(e) as being anticipated by Dehlin. In the Amendment dated August 29, 2007, Applicants explained in detailed how many recited limitations of the pending claims are not disclosed by Dehlin. In response, the Examiner withdrew the rejection under §102(e), and presented the new rejection under §103(a). The Examiner states "Applicants' arguments...have been considered but are moot in view of the new ground(s) for rejection."

Applicants respectfully note that the Examiner cites the new reference Goodspeed only for the alleged disclosure of "receiving an original electronic message addressed to a telephone number" and "determining an instant message identifier associated with the telephone number." For all of the other limitations, the Examiner still relies on Dehlin. Thus, Applicants' arguments as to why Dehlin does not disclose the claimed limitations other than the two limitations for which the Examiner has cited Goodspeed are not moot. However, the Examiner failed to address any of these arguments.

More specifically, assuming only for the sake of argument that Goodspeed does disclose "receiving an original electronic message addressed to a telephone number" and "determining an instant message identifier associated with the telephone number," and that furthermore there exists sufficient motivation to combine Goodspeed and Dehlin, the Examiner is still relying on Dehlin for many claimed limitation that Dehlin simply fails to disclose or suggest.

For the claim 1 third element, "determining in real time whether an instant message receiver is currently available to receive messages addressed to the instant message identifier," the Examiner cited "(Dehlin, col. 5 lines 13-21, msn messenger, col.

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7 lines 20-25, chat)." Applicants respectfully traverse. Dehlin does not inquire into "whether an instant message receiver is currently available...." Dehlin suggests that the receiver state is not effective: "[T]he instant messaging service maintains a list of aliases and their corresponding state in a database. The state corresponding to the alias for a mobile device will typically indicate offline. This offline state indicates to other IM aliases that the alias is not available for chatting. However, the instant messaging service allows an IM alias to send an IM message to an alias that appears offline." (Dehlin col. 6 lines 42-48).

As to the claim 1 element, "and performing a step from a group of steps consisting of: forwarding the electronic message as an instant message addressed to the instant message identifier in response to a determination that an instant message receiver is available to receive instant messages addressed to the instant message identifier" the Examiner cited "(Dehlin, col. 6 lines 35-60, alias status, computing device)." Applicants respectfully traverse. Dehlin says nothing about basing decisions on the availability of an IM receiver, or on the "state" of the alias. Specifically, even if the state is "on-line," Dehlin does not indicate whether the IM is passed on to the IM device as it would be without his invention.

As to the claim 1 element, "and sending the electronic message to a mobile device at the telephone number in response to a determination that no instant message receiver is available to receive instant messages addressed to the instant message identifier" the Examiner cited "(Dehlin, col. 6 lines 35-60, mobile device)." Applicants respectfully traverse. Not only does Dehlin say nothing about basing decisions on the availability of an IM receiver, neither does he base decisions on whether the mobile device is turned on or off: "At block 508, the customized SMS message is sent to the mobile device. In overview, the mobile device is typically in a 'sleep' state unless actively engaged in some activity, such as a telephone call or using a Web browser. Even though the mobile device is in a 'sleep' state, the mobile device may accept and receive SMS messages. Thus, at block 510, the mobile device receives the customized SMS message." (Dehlin col. 7 lines 4-10).

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The Examiner alleged "[f]or claim 2, Dehlin teaches, the method of claim 1, wherein the electronic message comprises any of: a text message, an SMS text message, an MMS message, a video message, and an audio message. (Dehlin, col. 5 lines 1-5, sms)." Applicants respectfully traverse. Neither in the cited passage nor elsewhere does Dehlin mention an MMS message, a video message, or an audio message.

The Examiner alleged "[f]or claim 4, Dehlin teaches, the method of claim 3, wherein the electronic device comprises any of: a computer, a personal data assistant (PDA), and a telephone receiver. (Dehlin, col. 6 lines 12-27, cell phone)." Applicants respectfully traverse. Claim 4 claims an instant message received at an electronic device which may be a telephone. The cited passages of Dehlin say nothing about instant messages; they discuss SMS text messages. Dehlin explains: "At block 508, the customized SMS message is sent to the mobile device." (col. 7 lines 4-5).

The Examiner alleged "[f]or claim 6, Dehlin teaches... determining whether or not to forward the electronic message as an email message addressed to an email address according to a user preference stored in a database. (Dehlin, col. 6 lines 35-45, "alias not available.")." Applicants respectfully traverse. Dehlin says nothing about forwarding messages as e-mails, much less according to a user preference.

The Examiner alleged "[f]or claim 7, Dehlin teaches... determining whether or not to forward the electronic message as an instant message addressed to the instant message identifier according to a user preference stored in a database. (Dehlin, col. 5 lines 13-21)." Applicants respectfully traverse. Neither in the cited passage nor elsewhere does Dehlin mention storing user preferences in a database, much less whether or how to forward messages based on preferences.

The Examiner alleged "[f]or claim 8, Dehlin teaches, the method of claim 7, wherein the determining whether or not to forward is further based on source

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information of the electronic message. (Dehlin, col. 6 lines 35-60, database, col. 7 lines 4-15, sleep)." Applicants respectfully traverse. Neither in the cited passages nor elsewhere does <u>Dehlin</u> mention determining whether to forward an electronic message, much less based on source information of the electronic message.

-- The Examiner alleged "[f]or claim 9, Dehlin teaches, the method of claim 8, wherein the source information comprises any of: a source address of the electronic message, a user name of a sender of the electronic message, a telephone number of a sender of the electronic message, and an instant message identifier of a sender of the electronic message. (Dehlin, col. 6 lines 35-60, alias)." Applicants respectfully traverse. <u>Dehlin</u> does not base determinations on source information, much less on the claimed types of source information.

The Examiner alleged "[f]or claim 10, Dehlin teaches... the instant message is generated from the electronic message based on one or more predetermined rules. (Dehlin, col. 7 lines 20-30, message)." Applicants respectfully traverse. The instant message referred to in claim 10 is generated from an electronic message addressed to a cell phone number. The IM generated by <u>Dehlin</u> relays an SMS reply from the receiver cell phone, which is addressed to the sender's IM alias: "The reply customized SMS message identifies the sender and includes an IM message indicator in the message type field. An IM/SMS application receives the reply customized SMS message and translates the reply customized SMS message into a reply IM message at block 614." (<u>Dehlin</u>, col. 7 lines 54-59).

The Examiner alleged "[f]or claim 11, Dehlin teaches, the method of claim 10, wherein the one or more predetermined rules select one or more portions of the electronic message as the instant message. (Dehlin, col. 7 lines 47-52, sms mobile device)." Applicants respectfully traverse. <u>Dehlin</u> does not use predetermined rules to select portions to generate instant messages. The cited passage of <u>Dehlin</u> says simply "At block 610, the IM client creates a reply customized SMS message based on the sender information and input obtained above."

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The Examiner alleged "[f]or claim 12, Dehlin teaches, the method of claim 10, wherein the one or more predetermined rules selectively delete one or more portions of the electronic message to generate the instant message. (Dehlin, col. 7 lines 47-52, sms mobile device)." Applicants respectfully traverse. Dehlin does not use predetermined rules to delete portions to generate instant messages.

The Examiner alleged "[f]or claim 13, Dehlin teaches... forwarding the electronic message to a storage medium. (Dehlin, col. 7 lines 41-46, reply)." Applicants respectfully traverse. Dehlin does not discuss forwarding messages to a storage medium.

The Examiner alleged "[f]or claim 14, Dehlin teaches... storing the electronic message in the storage medium. (Dehlin, col. 7 lines 32-40, computer)." Applicants respectfully traverse. Dehlin does not discuss storing messages in a storage medium.

The Examiner alleged "[f]or claim 15, Dehlin teaches... determining whether or not to forward the electronic message to the [sic, a] storage medium according to the user preference stored in the database. (Dehlin, col. 6 lines 35-60, database, col. 7 lines 4-15, sleep)." Applicants respectfully traverse. Dehlin col. 6 line 43 merely mentions a "database."

The Examiner alleged "[f]or claim 16, Dehlin teaches... forwarding the electronic message to the [sic, a] storage medium when the forwarding to the mail address and the instant message identifier fails. (Dehlin, col. 6 lines 35-60, database, col. 7 lines 4-15, sleep)." Applicants respectfully traverse. This rejection is invalid for the same reason as the rejection of claim 15.

The Examiner alleged "[f]or claim 17, Dehlin teaches, the method of claim 15, wherein the determining whether or not to forward is further based on source information of the electronic message. (Dehlin,) col. 6 lines 35-60, database, col. 7

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lines 4-15, sleep." Applicants respectfully traverse. This rejection is invalid for the same reason as the rejection of claim 15.

The Examiner alleged "[f]or claim 18, Dehlin teaches, the method of claim 15, wherein the user preference stored in the database comprises date and time preference of the instant message receiver. (Dehlin, col. 6 lines 35-45)." Applicants respectfully traverse. Dehlin does not mention a data or time preference.

The Examiner alleged "[f]or claim 19, Dehlin teaches... logging the forwarding the electronic message. (Dehlin, col. 7 line 66 to col. 8 line 11, sms)." Applicants respectfully traverse. Dehlin does not mention logging.

The Examiner alleged "[f]or claim 20, Dehlin teaches... blocking the forwarding of the electronic messages based on a list of telephone numbers. (Dehlin, col. 6 lines 35-60, alais)." Applicants respectfully traverse. Dehlin does not mention blocking forwarding of messages based on telephone numbers or elsewhere.

The Examiner alleged "[f]or claim 21, Dehlin teaches... the forwarding is based on the one or more predetermined rules. (Dehlin, col. 7 lines 47-55, customize)." Applicants respectfully traverse. The cited passage of Dehlin reads "At block 610, the IM client creates a reply customized SMS message based on the sender information and input obtained above," but does not teach forwarding based on predetermined rules.

Claims 22-61 recite the same elements of claims 1-21, relating to the same invention. Therefore, the supporting rationale of the rebuttals to the rejections to claims 1-21 applies equally well to claims 22-61.

For the record, Applicants respectfully traverse the assertion that Goodspeed discloses "receiving an original electronic message addressed to a telephone number" and "determining an instant message identifier associated with the telephone number"

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as recited by claim 1. Applicants further respectfully traverse the assertion that there exists sufficient motivation to combine Goodspeed and Dehlin. Applicants do not substantively address these issues at this time as it is not necessary to establish the patentability of the pending claims over the art of record. However, Applicants reserve the right to address these issues in the future if need be.

Applicants respectfully request that the Examiner withdraw all objections, and issue a timely Notice of Allowance in this case.

Should the Examiner find it helpful, he or she is encouraged to contact the Applicants' attorney Michael A. Glenn at (650) 474-8400.

Respectfully submitted,

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